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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,819	05/11/2006	Kazuhiko Ueda	2006_0509A	3671

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WENDEROTH, LIND & PONACK, L.L.P.  
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SUITE 800  
WASHINGTON, DC 20006-1021

EXAMINER
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MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/574,819	UEDA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Margaret G. Moore	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 to 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1712

1. Initially the Examiner notes that the claims are drawn to a "pressure sensitive adhesive composition" that is defined completely by the components in the composition. This recitation is not being given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. In this application, the body of the claim, the composition per se, does not depend upon this phrase for completeness since the compositional limitations are able to stand alone. On the other hand, note that products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In other words, if the prior teaches (A) to (C) as claimed, it will necessarily have pressure sensitive adhesive properties regardless of whether or not they are disclosed. If applicants are of the position that the prior art does not, in fact, possess the same properties as the claimed composition, the claimed composition should be amended to distinguish itself from the prior art.

With this in mind, the Examiner notes that claim 1 is extremely broad and that there are numerous anticipatory references. The Examiner will not apply all of them against claim 1 since this would be redundant.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1712

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Gutek et al.

Gutek et al. teach silicone polyethers with arylalkyl groups. Please see Example 1 in which an SiH compound having an average of 1.6 SiH groups is combined with a polyethylene oxide monoallyl ether and chloroplatinic acid. This meets each component required in the composition of claim 1 and thus anticipates this claim. The monoallyl group meets claim 6.

5. Claims 2, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutek et al.

The siloxane polymer in Example 1 differs from that in claim 2 in that it contains repeating "x" units that are not found in formula (I). However, as can be seen from the teachings on the bottom of column 1, these units are optional and do not need to be present in the Si-H containing siloxane. Thus one having ordinary skill in the art would have found the use of a siloxane comparable to that in Example 1 but having no dimethylsiloxo units to have been obvious in view of the totality of teachings in Gutek et al.

For claim 3, this claim too would have been obvious over the teachings in Gutek et al. On one hand, note the rationale supra regarding claim 2. Taking this position of obviousness one step further, note that the only difference between claim 3 and that which is rendered obvious (from the logic for claim 2) is the difference between 1.8 and 1.6. A prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. In the instant case, the difference between a composition having 1.6 SiH groups and 1.8 SiH groups does not appear to be

Art Unit: 1712

sufficient to lead one to expect different properties and this slight difference would appear to have been obvious to the skilled artisan.

On the other hand, the formula on the bottom of column 1 embraces siloxanes meeting that of claim 3. For instance, a "y" value of 2 will meet this claim. The disclosed range of 1 to 50 is a short hand way of saying 1 or 2 or 3 or 4.... Thus from this range one having ordinary skill in the art would have found the selection of a value of 2 to have been obvious.

For claim 5, note that column 3, lines 10 to 15, disclose that the polyether can have a molecular weight of up to about 7,500 (when summing the weight of the upper limit of "a" and "b" units). Since patentees weight range overlaps with that claimed, one having ordinary skill in the art would have found the selection of a molecular weight within the claimed range to have been obvious.

6. Claims 1, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2000 302981, herein '981 (cited by applicants), as interpreted by the English language translation.

At this time the Examiner is only able to review a machine generated English language of this reference.

'981 teaches a curable composition containing a polymer having alkenyl terminal groups, a compound having SiH groups and a Pt. catalyst. Particular attention is drawn to the working examples on page 12 of 13 in the English language translation. These compositions contain a polyether having allyl terminal groups and a molecular weight within the range of claim 5 and an SiH compound. According to that shown, the SiH compound has only 1 SiH group (this is consistent with that shown in the actual Japanese document, as well). Thus the compositions shown on page 12 anticipate the instant claims.

The Examiner realizes that paragraphs 44 and on actually define the siloxane compound as having two or more SiH groups. However since the examples clearly show a compound having one SiH group, this is an anticipatory example. On the other hand, since the siloxane requires at least two SiH groups, the skilled artisan would have

Art Unit: 1712

immediately envisioned such a polymer having two SiH groups, thus also anticipating the claims.

7. Claims 1 to 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2000 302981, herein '981, as interpreted by the English language translation.

In the event that a compound having 1 to 3 SiH groups is not anticipated by this reference, one having ordinary skill in the art would have found it obvious. The various siloxanes shown on pages 7 and 8 of the translation embrace siloxanes having 2 SiH groups, since this is the necessary number of SiH groups required. When having 2 SiH groups, these siloxanes will also meet the molecular weight requirement of claim 3.

For claim 2, note that the siloxane (15) on page 7 embraces this formula. Since R12 is limited to only two groups, one of which is methyl, the skilled artisan would have found a methyl R12 group obvious, if not anticipated. As noted above a siloxane having only 2 SiH groups is obviously suggested by '981, rendering obvious the claimed "m" value. Finally the breadth of "h" in siloxane 15 overlaps with the value of "n" in a manner such that one having ordinary skill in the art would have found the selection of such an "n" value to have been obvious.

For claim 4, note the bottom of page 8 of the translation which teaches a preferred ratio of .4 as a lower limit for the SiH to alkenyl group ratio. Since this is a specifically disclosed preferred point, the skilled artisan would have found the selection of a .4 ratio to have been obvious.

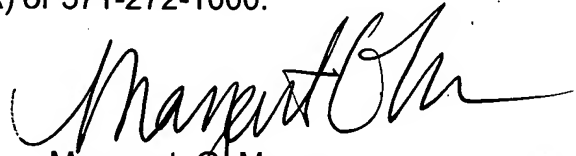
8. 5,288,831 (Ex. 1); 6,437,162 (Ex. 4), 6,987,157 (Ex. 4 and 5) and 6,593,436 (Ex. 17 and 18) each show compositions having the required components (A) to (C) in claim 1 (see paragraph 1, *supra*).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

Art Unit: 1712

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
2/12/07